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▷

In re HEINLE

Court of Customs and Patent Appeals

Appl. No. 7233

Decided Apr. 8, 1965

United States Patents Quarterly Headnotes

**PATENTS**

**[1] Patentability -- Anticipation -- Patents -- On copending applications (§ 51.2219)**  
 Patent issued on applicant's copending application is not prior art.

**PATENTS**

**[2] Claims--Aggregation or combination (§ 20.05)**  
 Inclusion of element in claim to combination does not make the claim a claim to the element, nor is element "claimed" therein; what is claimed is the totality of what is set forth.

**PATENTS**

**[3] Double patenting--In general (§ 33.1)**  
 Claims to element are not rejected for double patenting over applicant's patent claiming combination of this element and four other elements since claimed element is not the essential distinguishing feature of combination.

**PATENTS**

**[4] Double patenting--In general (§ 33.1)**  
**Patent grant--In general (§ 50.01)**  
 Issuance of patent is no guarantee or even a representation that everything disclosed in it is immediately free of patent or other restraints legally created under the law; should there be such other

patents still in force when patent expires, monopoly of expiring patent is not "extended"; that monopoly ends and any other patents which may affect rights of public to use something the expiring patent discloses stand on their own legal foundation; expiration of patent right is not guarantee of right to use; right to make, use, or vend any given thing may be subservient to several patents expiring at different times.

**PATENTS**

**[5] Disclaimer--In general (§ 32.1)**  
**Double patenting--In general (§ 33.1)**  
 Following rejection of claims for double patenting over applicant's patent, applicant filed terminal disclaimer to reduce term of any patent granted on application to that of patent and a disclaimer of sole claim of patent; disclaimers remove reasons frequently cited in support of double patenting rejections, to wit, extension of monopoly in point of time and prevention of issuance of two patents on one invention; there is no support for double patenting rejection.

**PATENTS**

**[6] Amendments to patent application--New matter (§ 13.5)**  
**Amendments to patent application--Specification (§ 13.7)**  
 Drawings and specification may be amended to conform to each other; added matter is not technical "new matter" within prohibition of 35 U.S.C. 132.

**PATENTS**

**Particular patents--Toilet Paper Core**  
 Heinle, Toilet Paper Core, claims 1 to 6 of application allowed.

**\*132 Appeal from Board of Appeals of the Patent Office.**

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Application for patent of Lawrence A. Heinle, Serial No. 816,848, filed May 29, 1959; Patent Office Group 440. From decision rejecting claims 1 to 6, applicant appeals. Reversed; Almond, Judge, concurring, with whom Martin, Judge, joins, with opinion.

NAYLOR & NEAL and KARL A. LIMBACH, both of San Francisco, Calif., for appellant.

CLARENCE W. MOORE (FRED W. SHERLING of counsel) for Commissioner of Patents.

Before RICH, Acting Chief Judge, MARTIN, SMITH, and ALMOND, Associate Judges, and KIRKPATRICK, Judge. [FNa1]

RICH, Judge.

This appeal is from the decision of the Patent Office Board of Appeals affirming the rejection of claims 1-6, all claims in application serial No. 816,848, filed May 29, 1959, entitled "Toilet Paper Core." This application is stated to be a continuation-in-part of application serial No. 271,938, filed February 16, 1952, on which Patent No. 2,889,121 issued June 2, 1959. The main issue is double patenting.

#### The Invention

The invention is an improvement in the cylindrical cardboard core on which the commonly-used roll of toilet paper is wound. The fixtures of one common type used to support such rolls are provided with cylindrical spindles having two telescoping parts which expand axially under the influence of a spring so that the spindle ends engage in sockets. In removing such a spindle from the fixture after the paper has been consumed it is necessary to grasp the spindle and move it axially. There is some difficulty in doing this when the spindle is covered by the empty cardboard core. We quote the apt description of the specification:

\* \* \* the close spacing of the ends of the support spindle\* \* \* with respect to the adjacent sidewalls of [the] holder \* \* \* makes difficult, finger insertion therebetween for the

purpose of removal of the spindle by effecting the above described axial movement of same. As a consequence nails are broken and fingers are pinched in the process of spindle removal. Further, it is difficult to effect sufficient axial movement of the spindle for its removal from the holder by employing the alternate method of collapsing the core about the spindle, because of the problem of getting sufficient gripping engagement between the core and the typically slick surfaced spindle.

The invention obviates this difficulty and resides in the provision of a pair of opposed elongated slots in the core large enough so that the spindle can be gripped through the slots for removal. Claim 3, which we have broken up into lettered clauses, reads:

- 3. A toilet paper core
  - [a] adapted for use with support spindle insertable within the core and requiring axial movement through an operating distance for its removal from spindle end support means,
  - said core being
  - [b] of tubular shape
  - [c] having diametrically opposed apertures disposed centrally of the length of the core,
  - [d] with the circumferential width of each of said apertures being approximately one-fourth of the circumference of said core
  - [e] thereby permitting passage there-through of fingers for access to and gripping of said support spindle
  - [f] and that axial length of said apertures being at least as large as said width plus said operating distance.

Claims 1-5 are all directed to "A toilet paper core" but claim 6, rejected on different grounds, is directed to a combination. It reads as follows:

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6. In combination,  
 [A] a support spindle having means for expanding and contracting\*133 said spindle axially thereof for an operating distance sufficient to permit insertion and removal of said spindle between opposed spindle receiving walls and latching of said spindle in said walls and

[B] a tubular toilet paper core

[1] mounted on side [said] spindle and

[2 having in its side wall opposed apertures

[i] the circumferential width of each of said apertures being approximately one-fourth of the circumference of said core

[ii] thereby permitting passage there through of fingers for access to and gripping of said support spindle

[iii] and the axial length of said apertures being at least as large as said width plus said operating distance.

The correspondence of [2], [i], [ii], and [iii] to limitations [c], [d], [e], and [f] of claim 3 will be apparent.

#### The Rejection

The examiner and the board relied on three references:

Heinle, 2,889,121, June 2, 1959.

Schwarzkopf, 1,860,058, May 24, 1932.

McConnell, 2,889,122, June 2, 1959.

[1] Heinle is appellant's own patent, above referred to, issued on the parent application of the application at bar. The application were copending and it is not "prior art." It is unnecessary to discuss Schwarzkopf or McConnell as they were cited only to show the

admittedly old, conventional, telescoping spindles with which appellant's apertured core is used.

There are two grounds of rejection now relied on as summarily stated in the Patent Office Solicitor's brief: claims 1-6 are rejected on the ground of double patenting in view of the Heinle patent and claims 3 and 6 are additionally rejected as "including subject matter having no clear basis in the application as filed."

#### The Double Patenting Rejection

In considering this rejection we will first state more specifically that claims 1-5 were rejected, in the words of the board, "on the ground of double patenting with respect to the single claim of the Heinle patent." Claims 6 was rejected, again in the board's words, "as unpatentable over the Heinle patent claim in view of either Schwarzkopf or McConnell."

As to claims 1-5, we shall deal with them together since no one has pointed to any reason for distinguishing them on the double patenting rejection, or even pointed out the differences between them. As above stated, they are all directed to the core structure *per se*. The position of the examiner as distilled in his Answer was that "The structure of the core recited in these [appealed] claims is deemed to be clearly disclosed and claimed in the Heinle patent." The board accepted this view and affirmed on it, adding its own further thought, as follows:

\* \* \* the *combination* claimed in the patent *includes* the core tube details of the instant separately claimed sub-combination, as an essential distinguishing feature of said *combination*. Under these circumstances, different concepts are not involved, the *inventions are not distinct*, and double patenting is present. *In re Coleman et al.*, 38 CCPA 1156, 90 USPQ 100, 189 F.2d 976, 1951 C.D. 475, 650 O.G. 926.

Accordingly, the instant rejection of claims 1 through 5 will be sustained. [Emphasis ours.]

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As the issue revolves around just what the Heinle patent does claim in its single claim, which the board admitted is to a combination, we set it forth broken down into its elements:

In combination with

[A] a cylindrical core-mounting spindle having diametrically opposed, axially extending slots therein.

[B] holding elements pivotally mounted in said slots for swinging movement from positions within said slots to positions in which they protrude from said slots,

[a] at least one pair of said holding elements being swingable in opposite directions about their respective pivots,

[C] spring means for urging said holding elements toward the positions in which they protrude from said slots,

[D] said slots being provided with abutments to limit the amount of protrusion of said holding elements,

[E] and a core for a roll of paper adapted to be circumscribed on the spindle, said core comprising

[a] a readily frangible tube adapted to be sleeved on the spindle and having

[i] diametrically opposed slots through its walls for receiving said holding elements with the holding elements of said pair disposed adjacent opposite end walls of the slots for restricting relative axial motion between said spindle and said core,

\*134 [ii] the slots in said core being of such width and length as to permit the free passage of an operator's fingers therethrough to release said holding elements.

Our first point of disagreement is with the examiner's view that the Heinle patent *claims* the core of the appealed claims 1-5. It should be perfectly clear that it claims a *combination* of the five elements denoted as A, B, C, D, and E. The core is but a single element in that combination, namely E, and it makes no difference to the discussion whether we call it an element or a "sub-combination" as the Patent Office has done. We think it is more properly denoted an element, notwithstanding the detailed specifications given for that element in the claim. [2] It is a single thing. The *inclusion* of an element in a claim to a combination does not make the claim a claim *to* the element, nor is the element "claimed" therein. What is claimed is the totality of what is set forth and what is set forth here very distinctly is a *combination* of five specific elements, each described in more or less detail. The examiner erred in holding that the core of element E is "claimed in the Heinle patent." [FN1]

The examiner said that the core element is "clearly disclosed" in the Heinle patent, as of course it is, otherwise the present application would not be a continuation-in-part thereof, but we do not see what bearing that fact has on the issue before us.

Our second point of disagreement is with the board's application of *In re Coleman et al.*, 38 CCPA 1156, 189 F.2d 976, 90 USPQ 100, in which this court *reversed* a double patenting rejection. The board has quoted but a few words from a long paragraph which is a general discussion of the law, the whole of which contains more support for appellant than it does for the rejection. Among other things, the paragraph says (90 USPQ at 102):

It is settled law that a party might be entitled to a patent for a combination *because of the cooperation of the elements contained therein*, and at the same time be entitled to a separate patent for one of the elements of the combination. \* \* \* where the element does not constitute the sole distinguishing novelty in the combination the inventions are distinct and double patenting will not be found. [Original emphasis.]

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Even were we to accept the board's view of the law, for which it cited Coleman, we would still not agree with its conclusion for the further reason that we do not agree that the apertured tubular core "sub-combination," as it calls it, is the "essential distinguishing feature" of the combination of the sole claim of the Heinle patent. A mere look at the claim refutes the idea. What the patent describes and claims as the invention involves a special wooden spindle (not of the endwise telescoping type but of the kind having end pins to drop in slots in a wall bracket), containing recesses in which spring-actuated holding elements are mounted to project outwardly and engage the ends of apertures in the tubular core of the toilet paper roll *to prevent it from shifting axially* on the spindle. All of this mechanism is elaborately set forth in the claim as a novel combination.

Appellant has now brought before us an application which describes the *same* apertured core described in the patent, to be sure, together with added description of *different* commonplace spindles of the endwise telescoping variety, and is urging the patentability of claims to this *element* (claims 1-5) as a patentable invention on its own account and of a claim (6) to the combination of this novel element (novelty not being questioned) with an old element, namely the *telescoping* spindle, which is not even shown in the patent.

[3] We do not find the grounds of rejection as stated by the examiner and the board under the head of double patenting to be supportable in fact or in law. Without considering several other matters in the record and briefs, we feel constrained to reverse the double patenting rejection for the above reasons. We do take note, however, of certain points worthy of mention.

\*135 The examiner indicated in his Answer that he was troubled by the thought "that after the expiration of the Heinle patent to the combination of the spindle and core, the public should be entitled to make and use the core set forth in the claim of the patent. The granting of a second patent claiming the same structure of the core but merely describing it as for a different use appears

to improperly extend the monopoly of the first patent." We think we sufficiently answered this type of argument, which we consider legally unsound, in our recent opinion in *In re Sarett*, 51 CCPA 1180, 327 F.2d 1005, 140 USPQ 474, particularly in the 7th, 8th, and 9th paragraphs following the heading "The Relationship between Appellant's and the Patentees' Inventions." [4] The issuance of a patent is no guarantee or even a representation that everything disclosed in it is immediately free of patent or other restraints legally created under the law. Should there be such other patents still in force when a patent expires, the monopoly of the expiring patent is not "extended"; that monopoly ends and any other patents which may affect the rights of the public to use something the expiring patent discloses stand on their own legal foundations. The expiration of a patent right is not a guarantee of a right to use. The right to make, use or vend any given thing may be, and often is, subservient to several patents expiring at different times. Cf. *In re Mogen David Wine Corp.*, 51 CCPA 1260, 328 F.2d 925, 140 USPQ 575.

Claim 6 deserves a word in addition to claims 1-5. We find the latter claims directed to the core *per se* to have been improperly rejected for double patenting because the Patent Office was wrong in contending they are directed to the essential distinguishing feature of the combination claimed in the patent if, indeed, it does not contend that the patent actually claims the core, which we have held it does not do.

Claim 6, *supra*, is drawn to a combination of the novel core and an old telescoping spindle. As to it the solicitor's brief says, erroneously, "claim 6 recites specifically the same combination as that of the patent, since the claim [6] does not exclude the holding elements." This is a non sequitur. Inspection of claim 6 will show that it is drawn to a different combination from the claim of the patent. Specifically, in claim 6 element A is an axially telescoping or expending spindle; in the patent claim, *supra*, the spindle structure is made of the subcombination of elements A, B, C, and D, a very different mechanism. The fact that claim 6 on

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appeal does not *exclude* holding elements is of no relevancy. The fact is it is drawn to the combination of a specific type of spindle, which is old, different from that claimed in the patent, and the specific core element, which is new. The functional relationships of the elements of the two combinations are different. We feel that claim 6 is a proper alternative way of claiming appellant's invention. The functional advantage of the core of claims 1-5 when it is used with the conventional telescoping spindle is that it simplifies the removability of the old telescoping spindle and this appears to be a new functional relationship justifying a claim to this combination of the new with the old element as a new combination. It has not been contended that the combination lacks novelty, or would have been obvious, and it certainly possesses more than enough utility to satisfy the law.

#### The Disclaimers

Appellant, following the board's initial decision affirming the rejection, filed a request for reconsideration and at the same time filed (1) a terminal disclaimer in the application at bar, reducing the term of any patent granted thereon to that of the issued Heinle patent, and (2) a disclaimer of the sole claim of the patent. Appellant's purpose was to dispose conclusively of the arguments that (1) allowance of the appealed claims would result in extension of the monopoly of the patent beyond its expiration date and (2) that it would be obtaining two patents on one invention.

The board, citing *In re Siu*, 42 CCPA 864, 222 F.2d 267, 105 USPQ 428, and other cases, refused to give any effect to the disclaimers, commenting,

\* \* \* the pertinent statutes do not "warrant the allowance of more than one patent for a single invention independently of the question of extension of monopoly". We deem it immaterial that in these cases there may have been only a terminal disclaimer involved and not as here a disclaimer of the prior patent in addition, since the basic doctrine enounced therein is not affected by the latter disclaimer.

We find the board's position somewhat difficult to understand. It apparently proceeded wholly on its theory that there is only one invention here. We have already stated why we disagree with that. In *In re Dubois*, 46 CCPA 744, 262 F.2d 88, 120 USPQ 198, also cited by the board, where we found two inventions to exist, as we do here, we held that a terminal disclaimer "effectively" \*136 removed from the case any issue of extension of the monopoly \* \* \*. We find the terminal disclaimer here to have a similar effect. In *In re Robeson*, 51 CCPA 1271, 331 F.2d 610, 141 USPQ 485, we held that a terminal disclaimer overcame the extension of monopoly objection to issuing a patent on "an obvious variation" of an invention claimed in an issued patent to the applicant and reversed the "double patenting" rejection. We followed that holding in *In re Kaye*, 51 CCPA 1465, 332 F.2d 816, 141 USPQ 829, and again reversed a double patenting rejection. (We note that these holdings as well as *In re Sarett*, *supra*, have all been subsequent to the board's second opinion herein.)

As to the objection that there would be two patents for the same invention, this court held in *In re Hession*, 49 CCPA 809, 296 F.2d 930, 132 USPQ 40 (and the dissenters there were in agreement with the proposition) that a disclaimer of all claims of a patent was effective in removing such an objection. We think it is so effective here.

[5] It should be clear that we do not find it necessary to rely on the disclaimers, or either of them, to reverse in this case. We nevertheless hold the disclaimers to be effective in removing two of the frequently cited reasons given in support of double patenting rejections, extension of monopoly in point of time and prevention of the issuance of two patents on one invention. With the disclaimers of record, we can find no possible support for the double patenting rejections in this case.

#### Claims 3 and 6

There remains the rejection of these claims because they contain a limitation said to be without support in the disclosure. The limitation is that the width of the apertures in the core is "approximately

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one-fourth of the circumference of said core." ([d] in claim 3 and [2][i] in claim 6.) The examiner termed this a "mathematical dimension" and, finding no specific mention of it in the *words* of the specification, rejected appellant's argument that the width dimension of these claims is shown in the drawings and ruled that

\* \* \* a patent drawing does not define the precise proportions of the elements depicted and thus may not be relied on to show particular distances or sizes when the specification is completely silent in that respect. See *In re Olson*, 212 F.2d 590, 101 USPQ 401 [41 CCPA 871].

The board fully accepted this rejection and reasoning and added, in its second opinion, that

\* \* \* while Figure 2 might be said to depict a slot width of substantially the circumferential proportion involved [,] Figures 1 and 4 clearly do not.

First, we note the inexact nature of the limitation, "approximately one-fourth of the circumference" and its function in merely having opposed apertures of sufficient size to permit the fingers and thumb to grasp the spindle through them. In the Olson case this court (one judge dissenting) affirmed a refusal to permit reliance on patent drawings of a hydraulic hose coupling containing ball valves in support of claim limitations relating to dimensions "of the order of a few thousandths of an inch." We think the facts there clearly distinguish the *holding* of that case from the situation at bar. In the opinion in Olson the court said (101 USPQ at 402):

The board correctly held, however, that it is proper in support of claims which otherwise could not be allowed, to amend the specification of a pending application to include new matter clearly and conclusively disclosed by the drawings. *Bloodhart v. Levernier*, 20 CCPA 917, 64 F.2d 367, 17 USPQ 188; *Wiemer v. Coe, Comr. Pats.*, 45 USPQ 407.

[6] This is the familiar rule that the drawings and the specification may be amended to conform to each other and that the added matter will not be deemed technical "new matter" within the prohibition of the law. 35 U.S.C. 132, Rule 118. See also our further discussion of the Olson case in *In re Wolfensperger*, 49 CCPA 1075, 302 F.2d 950, 133 USPQ 537.

Our inspection of the application drawings leads us to agree with the board that Fig. 2 depicts a pair of slots with the claimed width dimensions and to disagree that Figs. 1 and 4 fail to show that same dimension. The latter figures are perspective views and it seems to us that they conform to the one-fourth circumference limitation almost exactly. But the claim requires only an approximation. Since we believe an amendment to the specification to state that one-fourth of the circumference is the aperture width would not violate the rule against "new matter," we feel that supporting disclosure exists. This rejection was therefore in error.

The decision of the board is *reversed*.

FN1 United States Senior Judge for the Eastern District of Pennsylvania, designated to participate in place of Chief Judge Worley, pursuant to provisions of Section 294(d), Title 28, United States Code.

FN1 We have considered the word "with" in the opening clause. In our opinion the meaning that must be given to it is, "in combination *with* A, elements B, C, D, and E." With that type of opening it *might* be that the claim would go on to describe details of an element A and then state the combination to be one of A *with* E. That is not the case here. Note the word "and" as preceding element E, grammatically the last element of the five enumerated. If it had been intended to claim a two-element combination of the novel element E with an old spindle, clause E would appropriately have been introduced by the word "of." Alternatively, the style of claim

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6 at bar would have been used, omitting the word "with" and joining the two elements with the conjunctive "and." We have studied the patent specification and while it is in some ways pointed toward the core being the primary invention that is certainly not what is claimed.

ALMOND, Judge, concurring, with whom MARTIN, Judge, joins.

I would reverse the double patenting \*137 rejection because of the terminal disclaimer filed by appellant. In re Robeson, 51 CCPA 1271, 331 F.2d 610, 141 USPQ 485. I cannot agree with the majority that it is unnecessary to rely upon the disclaimers in order to reverse the board. The core claimed in the application before us is obvious in view of the core which is an element of the patent claims. Thus, allowance of the present application without a terminal disclaimer would result in an unlawful extension of the monopoly. See my dissenting opinion in In re Allen, 52 CCPA 1315, 343 F.2d 482, 145 USPQ 147.

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Vas-Cath Inc.

v.

Mahurkar

Court of Appeals, Federal Circuit

Nos. 90-1528, 91-1032

Decided June 7, 1991

United States Patents Quarterly Headnotes

#### **JUDICIAL PRACTICE AND PROCEDURE**

**[1] Procedure - Summary judgment - In general (§ 410.3301)**

**Procedure - Judicial review - Standard of review - In general (§ 410.4607.01)**

Court of appeals, in reviewing grant of summary judgment, is not bound by federal district court's holding that no material facts are in dispute, and must make independent determination as to whether standards for summary judgment have been met.

#### **PATENTS**

**[2] Patentability/Validity - Specification - Written description (§ 115.1103)**

"Written description" of invention required by first paragraph of 35 USC 112 is separate and distinct from that paragraph's requirement of enabling disclosure, since description must do more than merely provide explanation of how to "make and use" invention; applicant must also convey, with reasonable clarity to those skilled in art, that applicant, as of filing date sought, was in possession of invention, with invention being, for purposes of "written description" inquiry, whatever is presently claimed.

#### **PATENTS**

**[3] Practice and procedure in Patent and**

**Trademark Office - Prosecution - Drawings (§ 110.0920)**

**Patentability/Validity - Specification - Written description (§ 115.1103)**

Drawings alone may, under proper circumstances, provide "written description" of invention required by 35 USC 112, and whether drawings are from design application or utility application is not determinative.

#### **PATENTS**

**[4] Patentability/Validity - Specification - Written description (§ 115.1103)**

Federal district court erred by requiring drawings from design patent application to "describe what is novel or important" about invention in order to satisfy "written description" requirement of 35 USC 112 for later-filed utility patent on double lumen catheter having combination of features, since there is no legally cognizable or protected "essential" element, "gist" or "heart" of invention in combination patent; rather, invention is defined by claims under consideration.

#### **PATENTS**

**[5] Patentability/Validity - Specification - Written description (§ 115.1103)**

Federal district court erred by considering patents granted to applicant after utility patents containing claims in question in determining whether drawings from design application satisfy "written description" requirement of 35 USC 112 for those claims, since later patenting of inventions having different specifications is irrelevant to determination of Section 112 sufficiency of application in question, which must be judged as of its filing date.

#### **PATENTS**

**[6] Patentability/Validity - Specification - Written description (§ 115.1103)**

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Federal district court erred by imposing legal standard that essentially required drawings from design application for double lumen catheter to necessarily exclude all diameters of lumens, other than those within range specified by subsequently-filed utility claims, in order to satisfy "written description" requirement of 35 USC 112 for those claims, since proper test is whether drawings conveyed, with reasonable clarity to those of ordinary skill in art, that applicant had in fact invented catheter having return lumen of diameter within claimed range; defendant's submission of expert's declaration stating that person of ordinary skill viewing drawings would be able to derive claimed range therefrom, and plaintiff's failure to refute such declaration, therefore gave rise to genuine issue of material fact inappropriate for summary disposition.

## PATENTS

### Particular patents - General and mechanical - Catheters

4,568,329, Mahurkar, double lumen catheter, summary judgment of invalidity reversed.  
4,692,141, Mahurkar, double lumen catheter, summary judgment of invalidity reversed.

**\*1112** Appeal from the U.S. District Court for the Northern District of Illinois, Easterbrook, J.; 17 USPQ2d 1353.

Action by Vas-Cath Inc. and Gambro Inc. against Sakharam D. Mahurkar and Quinton Instruments Co., for declaratory judgment of patent non-infringement, in which defendants counterclaim for patent infringement. From entry of summary judgment holding patents invalid, defendants appeal. Reversed and remanded.

William L. Mentlik, of Lerner, David, Littenberg, Krumholz & Mentlik (Roy H. Wepner, John R. Nelson, and Joseph S. Littenberg, with him on brief), Westfield, N.J., for plaintiffs-appellees.

Raymond P. Niro, of Niro, Scavone, Haller & Niro, Chicago, Ill. (Joseph N. Hosteny and John C. Janka, with him on brief; Michael P. Mazza, of

counsel); Michael J. Sweedler, of Darby & Darby, New York, N.Y., for defendants-appellants.

Before Rich, Michel, and Plager, circuit judges.

Rich, J.

Sakharam D. Mahurkar and Quinton Instruments Company (collectively Mahurkar) appeal from the September 12, 1990 partial final judgment [FN1] of the United States District Court for the Northern District of Illinois, Easterbrook, J., sitting by designation, in Case No. 88 C 4997. Granting partial summary judgment to Vas-Cath Incorporated and its licensee Gambro, Inc. (collectively Vas-Cath), the district court declared Mahurkar's two United States utility patents Nos. 4,568,329 ('329 patent) and 4,692,141 ('141 patent), titled "Double Lumen Catheter," invalid as anticipated under 35 USC 102(b). In reaching its decision, reported at 745 F.Supp. 517, 17 USPQ2d 1353, the district court concluded that none of the twenty-one claims of the two utility patents was entitled, under 35 USC 120, to the benefit of the filing date of Mahurkar's earlier-filed United States design patent application Serial No. 356,081 ('081 design application), which comprised the same drawings as the utility patents, because the design application did not provide a "written description of the invention" as required by 35 USC 112, first paragraph. We *reverse* the grant of summary judgment with respect to all claims.

## BACKGROUND

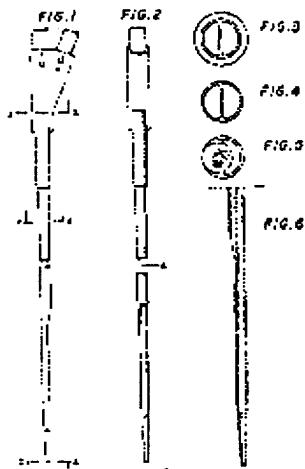
Sakharam Mahurkar filed the '081 design application, also titled "Double Lumen Catheter," on March 8, 1982. The application was abandoned on November 30, 1984. Figures 1-6 of the '081 design application are reproduced at right [below].

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As shown, Mahurkar's catheter comprises a pair of tubes (lumens) designed to allow blood to be removed from an artery, processed in an apparatus that removes impurities, and returned close to the place of removal. Prior art catheters utilized concentric circular lumens, while Mahurkar's employs joined semi-circular tubes that come to a single tapered tip. Advantageously, the puncture area of Mahurkar's semicircular catheter is 42% less than that of a coaxial catheter carrying the same quantity of blood, and its conical tip yields low rates of injury to the blood. The prior art coaxial catheters are now obsolete; Mahurkar's catheters appear to represent more than half of the world's sales. 745 F.Supp. at 520, 17 USPQ2d at 1353-54.

After filing the '081 design application, Mahurkar also filed a Canadian Industrial Design application comprising the same \*1113 drawings plus additional textual description. On August 9, 1982, Canadian Industrial Design 50,089 (Canadian '089) issued on that application.

More than one year later, on October 1, 1984, Mahurkar filed the first of two utility patent applications that would give rise to the patents now on appeal. Notably, both utility applications included the same drawings as the '081 design application. [FN2] Serial No. 656,601 ('601 utility application) claimed the benefit of the filing date of the '081 design application, having been

denominated a "continuation" thereof. In an Office Action mailed June 6, 1985, the Patent and Trademark Office (PTO) examiner noted that "the prior application is a design application," but did not dispute that the '601 application was entitled to its filing date. On January 29, 1986, Mahurkar filed Serial No. 823,592 ('592 utility application), again claiming the benefit of the filing date of the '081 design application (the '592 utility application was denominated a continuation of the '601 utility application). In an office action mailed April 1, 1987, the examiner stated that the '592 utility application was "considered to be fully supported by applicant's parent application SN 356,081 filed March 8, 1982 [the '081 design application]." The '601 and '592 utility applications issued in 1986 and 1987, respectively, as the '329 and '141 patents, the subjects of this appeal. The independent claims of both patents are set forth in the Appendix hereto.

Vas-Cath sued Mahurkar in June 1988, seeking a declaratory judgment that the catheters it manufactured did not infringe Mahurkar's '329 and '141 utility patents. [FN3] Vas-Cath's complaint alleged, *inter alia*, that the '329 and '141 patents were both invalid as anticipated under 35 USC 102(b) by Canadian '089. Vas-Cath's anticipation theory was premised on the argument that the '329 and '141 patents were not entitled under 35 USC 120 [FN4] to the filing date of the '081 design application because its drawings did not provide an adequate "written description" of the claimed invention as required by 35 USC 112, first paragraph.

Mahurkar counterclaimed, alleging infringement. Both parties moved for summary judgment on certain issues, including validity. For purposes of the summary judgment motion, Mahurkar conceded that, if he could not antedate it, Canadian '089 would represent an enabling and thus anticipating § 102(b) reference against the claims of his '329 and '141 utility patents. 745 F.Supp. at 521, 17 USPQ2d at 1355. Vas-Cath conceded that the '081 design drawings *enabled* one skilled in the art to practice the claimed invention within the meaning of 35 USC 112, first paragraph. *Id.* Thus, the question before the district court was whether the disclosure

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of the '081 design application, namely, the drawings without more, adequately meets the "written description" requirement also contained in §112, first paragraph, so as to entitle Mahurkar to the benefit of the 1982 filing date of the '081 design application for his two utility patents and thereby antedates Canadian '089.

Concluding that the drawings do not do so, and that therefore the utility patents are anticipated by Canadian '089, the district court held the '329 and '141 patents wholly invalid under 35 USC 102(b), *id.* at 524, 17 USPQ2d at 1358, and subsequently granted Mahurkar's motion for entry of a partial final judgment under Fed.R.Civ.P. 54(b) on the validity issue. This appeal followed.

#### DISCUSSION

The issue before us is whether the district court erred in concluding, on summary judgment, that the disclosure of the '081 design application does not provide a §112, first paragraph "written description" adequate to support each of the claims of the '329 and '141 patents. If the court so erred as to any of the 21 claims at issue, the admittedly anticipatory disclosure of Canadian '089 will have been antedated (and the basis for the court's \*1114 grant of summary judgment nullified) as to those claims.

[1] In reviewing the district court's grant of summary judgment, we are not bound by its holding that no material facts are in dispute, and must make an independent determination as to whether the standards for summary judgment have been met. *C.R. Bard, Inc. v. Advanced Cardiovascular Systems*, 911 F.2d 670, 673, 15 USPQ2d 1540, 1542-43 (Fed. Cir. 1990). Summary judgment will not lie if the dispute about a material fact is "genuine," that is, if the evidence is such that a reasonable jury could return a verdict for the nonmoving party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986).

*The "Written Description" Requirement of §112*  
The first paragraph of 35 USC 112 requires that

[t]he specification shall contain a *written description of the invention*, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

(Emphasis added). Application of the "written description" requirement, derived from the portion of §112 emphasized above, is central to resolution of this appeal. The district court, having reviewed this court's decisions on the subject, remarked that "[u]nfortunately, it is not so easy to tell what the law of the Federal Circuit is." 745 F.Supp. at 522, 17 USPQ2d at 1356. Perhaps that is so, and, therefore, before proceeding to the merits, we review the case law development of the "written description" requirement with a view to improving the situation. [FN5]

The cases indicate that the "written description" requirement most often comes into play where claims not presented in the application when filed are presented thereafter. Alternatively, patent applicants often seek the benefit of the filing date of an earlier-filed foreign or United States application under 35 USC 119 or 35 USC 120, respectively, for claims of a later-filed application. The question raised by these situations is most often phrased as whether the application provides "adequate support" for the claim(s) at issue; it has also been analyzed in terms of "new matter" under 35 USC 132. The "written description" question similarly arises in the interference context, where the issue is whether the specification of one party to the interference can support the claim(s) corresponding to the count(s) at issue, i.e., whether that party "can make the claim" corresponding to the interference count.

To the uninitiated, it may seem anomalous that the first paragraph of 35 USC 112 has been interpreted as requiring a separate "description of the invention," when the invention is, necessarily, the subject matter defined in the *claims* under

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consideration. See *In re Wright*, 866 F.2d 422, 424, 9 USPQ2d 1649, 1851 (Fed. Cir. 1989). One may wonder what purpose a separate "written description" requirement serves, when the second paragraph of §112 expressly requires that the applicant conclude his specification "with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

One explanation is historical: the "written description" requirement was a part of the patent statutes at a time *before* claims were required. A case in point is *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356 (1822), in which the Supreme Court affirmed the circuit court's decision that the plaintiff's patent was "deficient," and that the plaintiff could not recover for infringement thereunder. The patent laws then in effect, namely the Patent Act of 1793, did not require claims, but did require, in its 3d section, that the patent applicant "deliver a written description of his invention, and of the manner of using, or process of compounding, the same, in such full, clear and exact terms, as to distinguish the same from all things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound and use the same...."*Id.* at 430. In view of this language, the Court concluded that the specification of a patent had two objects, the first of which was "to enable artizans to make and use [the invention]. ..."*Id.* at 433. The second object of the specification was

to put the public in possession of what the party claims as his own invention, so as to ascertain if he claims anything that is in common use, or is already known, and to guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be \*1115 patented. It is, therefore, for the purpose of warning an innocent purchaser, or other person using a machine, of his infringement of the patent; and at the same time, of taking from the inventor the means of practising upon the credulity or the fears of other persons, by pretending that his invention is more than what it really is, or

different from its ostensible objects, that the patentee is required to distinguish his invention in his specification.

*Id.* at 434.

A second, policy-based rationale for the inclusion in §112 of both the first paragraph "written description" and the second paragraph "definiteness" requirements was set forth in *Rengo Co. v. Molins Mach. Co.*, 657 F.2d 535, 551, 211 USPQ 303, 321 (3d Cir.), *cert. denied*, 454 U.S. 1055 (1981):

[T]here is a subtle relationship between the policies underlying the description and definiteness requirements, as the two standards, while complementary, approach a similar problem from different directions. Adequate description of the invention guards against the inventor's overreaching by insisting that he recount his invention in such detail that his future claims can be determined to be encompassed within his original creation. The definiteness requirement shapes the future conduct of persons other than the inventor, by insisting that they receive notice of the scope of the patented device.

With respect to the first paragraph of §112 the severability of its "written description" provision from its enablement ("make and use") provision was recognized by this court's predecessor, the Court of Customs and Patent Appeals, as early as *In re Ruschig*, 379 F.2d 990, 154 USPQ 118 (CCPA 1967). Although the appellants in that case had presumed that the rejection appealed from was based on the enablement requirement of §112, *id.* at 995, 154 USPQ at 123, the court disagreed:

[T]he question is not whether [one skilled in the art] would be so enabled but whether the specification discloses the compound to him, specifically, *as something appellants actually invented*.... If [the rejection is] based on section 112, it is on the requirement thereof that "The specification shall contain a written description of the invention \* \* \*." (Emphasis ours.)

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*Id.* at 995-96, 154 USPQ at 123 (first emphasis added). The issue, as the court saw it, was one of fact: "Does the specification convey clearly to those skilled in the art, to whom it is addressed, in any way, the information that appellants invented that specific compound [claimed]?" *Id.* at 996, 154 USPQ at 123.

In a 1971 case again involving chemical subject matter, the court expressly stated that "it is possible for a specification to *enable* the practice of an invention as broadly as it is claimed, and still not *describe* that invention." *In re DiLeone*, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (CCPA 1971) (emphasis added). As an example, the court posited the situation "where the specification discusses *only* compound A and contains *no* broadening language of any kind. This might very well enable one skilled in the art to make and use compounds B and C; yet the class consisting of A, B and C has not been described." *Id.* at 1405 n.1, 168 USPQ 593 n.1 (emphases in original). See also *In re Ahlbrecht*, 435 F.2d 908, 911, 168 USPQ 293, 296 (CCPA 1971) (although disclosure of parent application may have *enabled* production of claimed esters having 2-12 methylene groups, it only *described* esters having 3-12 methylene groups).

The CCPA also recognized a subtle distinction between a written description adequate to *support* a claim under §112 and a written description sufficient to *anticipate* its subject matter under § 102(b). The difference between "claim-supporting disclosures" and "claim-anticipating disclosures" was dispositive in *In re Lukach*, 442 F.2d 967, 169 USPQ 795 (CCPA 1971), where the court held that a U.S. "grandparent" application did not sufficiently describe the later-claimed invention, but that the appellant's intervening British application, a counterpart to the U.S. application, anticipated the claimed subject matter. As the court pointed out, "the description of a single embodiment of broadly claimed subject matter constitutes a description of the invention for anticipation purposes ..., whereas the same information in a specification might not alone be enough to provide a description of that invention for purposes of adequate disclosure...." *Id.* at 970, 169 USPQ at 797 (citations omitted).

The purpose and applicability of the "written description" requirement were addressed in *In re Smith and Hubin*, 481 F.2d 910, 178 USPQ 620 (CCPA 1973), where the court stated:

Satisfaction of the description requirement insures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that the *prima facie* date of invention can fairly be held to be the filing date of the application. This concept applies whether \*1116 the case factually arises out of an assertion of entitlement to the filing date of a previously filed application under §120 ... or arises in the interference context wherein the issue is support for a count in the specification of one or more of the parties ... or arises in an *ex parte* case involving a single application, but where the claim at issue was filed subsequent to the filing of the application....

*Id.* at 914, 178 USPQ at 623-24 (citations omitted).

The CCPA's "written description" cases often stressed the fact-specificity of the issue. See, e.g., *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976) ("The primary consideration is *factual* and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure") (emphasis in original); *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) ("Precisely how close the description must come to comply with §112 must be left to case-by-case development"); *DiLeone*, 438 F.2d at 1405, 168 USPQ at 593 ("What is needed to meet the description requirement will necessarily vary depending on the nature of the invention claimed"). The court even went so far as to state:

[I]t should be readily apparent from recent decisions of this court involving the question of compliance with the description requirement of § 112 that each case must be decided on its own facts. Thus, the precedential value of cases in this area is extremely limited.

*In re Driscoll*, 562 F.2d 1245, 1250, 195 USPQ

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434, 438 (CCPA 1977).

Since its inception, the Court of Appeals for the Federal Circuit has frequently addressed the "written description" requirement of §112. [FN6] A fairly uniform standard for determining compliance with the "written description" requirement has been maintained throughout: "Although [the applicant] does not have to describe exactly the subject matter claimed, ... the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (citations omitted). "[T]he test for sufficiency of support in a parent application is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). Our cases also provide that compliance with the "written description" requirement of §112 is a question of fact, to be reviewed under the clearly erroneous standard. *Gosteli*, 872 F.2d at 1012, 10 USPQ2d at 1618; *Utter v. Hiraga*, 845 F.2d 993, 998, 6 USPQ2d 1709, 1714 (Fed. Cir. 1988).

There appears to be some confusion in our decisions concerning the extent to which the "written description" requirement is separate and distinct from the enablement requirement. For example, in \*1117 *In re Wilder*, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 1209 (1985), we flatly stated: "The description requirement is found in 35 U.S.C. §112 and is separate from the enablement requirement of that provision." However, in a later case we said, "The purpose of the [written] description requirement [of section 112, first paragraph] is to state what is needed to fulfill the enablement criteria. These requirements may be viewed separately, but they are intertwined." *Kennecott Corp. v. Kyocera Int'l, Inc.*, 835 F.2d 1419, 1421, 5 USPQ2d 1194, 1197 (Fed. Cir. 1987), *cert. denied*, 486 U.S. 1008 (1988). "The written

description must communicate that which is needed to enable the skilled artisan to make and use the claimed invention." *Id.*

[2] To the extent that *Kennecott* conflicts with *Wilder*, we note that decisions of a three-judge panel of this court cannot overturn prior precedential decisions. See *UMC Elec. Co. v. United States*, 816 F.2d 647, 652 n.6, 2 USPQ2d 1465, 1468 n.7 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1025 (1988). This court in *Wilder* (and the CCPA before it) clearly recognized, and we hereby reaffirm, that 35 USC 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the "written description" inquiry, whatever is now claimed.

#### *The District Court's Analysis*

We agree with the district court's conclusion that drawings alone *may* be sufficient to provide the "written description of the invention" required by § 112, first paragraph. Several earlier cases, though not specifically framing the issue in terms of compliance with the "written description" requirement, support this conclusion.

For example, we previously stated that "[t]here is no statutory prohibition against an applicant's reliance, in claiming priority under 35 U.S.C. §120, on a disclosure in a design application if the statutory conditions are met." *KangaROOS U.S.A., Inc. v. Caldor, Inc.*, 778 F.2d 1571, 1574, 228 USPQ 32, 33 (Fed. Cir. 1985). The question whether the applicant's claim to a pocket for athletic shoes was in fact entitled to the filing date of his earlier design application was not resolved in *KangaROOS*, however. Issues of intent to deceive the PTO were involved, as well as an error of law by the district court in construing the claims of the wrong application. *Id.* at 1574-75, 228 USPQ at

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34-35. The district court's grant of partial summary judgment of inequitable conduct was vacated and the case remanded for trial.

*In re Berkman*, 642 F.2d 427, 209 USPQ 45 (CCPA 1981) involved a claim under 35 USC 120 to the benefit of the filing date of two earlier design patent applications that included drawings of a carrying and storage case for tape cartridges and cassettes. The invention claimed in the later-filed utility application was an "insert" of "compartmented form," adapted for use in the interior of the storage case. *Id.* at 429, 209 USPQ at 47. The court characterized the dispositive issue as "whether the design applications sufficiently disclose the invention now claimed in the ... utility application at bar." *Id.* at 429, 209 USPQ at 46. While specifically recognizing that "drawings may be used to satisfy the disclosure requirement," *id.* at 429, 209 USPQ at 46-47, the court held that Berkman's design applications "fail [ed] to disclose the claimed invention sufficiently to comply with the requirements of §112 first paragraph." As the court explained:

Nowhere in the design applications is the word "insert" used, nor is there any indication that the interiors of the cases are inserts. The drawings do not disclose how the insert can be used to accommodate either cassette or cartridge type tape enclosures. Berkman argues that one skilled in the art would readily recognize that the interiors of the cases illustrated in the design drawings are inserts. We do not agree. There is nothing shown in the drawings to lead one of ordinary skill to such a conclusion.

*Id.* at 430, 209 USPQ at 47.

The issue in *In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537 (CCPA 1962) was whether the specification of the applicant's utility patent application disclosing a ball valve, and particularly the drawings thereof, supported a claim limitation that read: "having, in untensioned condition, a mean diameter corresponding approximately to the mean diameter of said chamber and a radial width smaller

than the radial width of said chamber...." *Id.* at 952, 133 USPQ at 538. The court did not agree with the Board's conclusion that the "radial width" relationship was not supported by applicant's figure 5:

The board's statement that "drawings alone cannot form the basis of a valid claim" is too broad a generalization to be valid and is, furthermore, contrary to well \*1118 settled and long-established Patent Office practice.... Consider, for one thing, that the sole disclosure in a design patent application is by means of a drawing. ... For another thing, consider that the only informative and significant disclosure in many electrical and chemical patents is by means of circuit diagrams or graphic formulae, constituting "drawings" in the case....

*Id.* at 955-56, 133 USPQ at 541-42.

Employing a "new matter" analysis, the court in *In re Heinle*, 342 F.2d 1001, 145 USPQ 131 (CCPA 1965) reversed a PTO rejection of the applicant's claims to a "toilet paper core" as "including subject matter having no clear basis in the application as filed." *Id.* at 1003, 145 USPQ at 133. The claim limitation said to be without support required that the width of the apertures in the core be "approximately one-fourth of the circumference of said core." *Id.* at 1007, 145 USPQ at 136. Having reviewed the application drawings relied upon for support, the court stated:

it seems to us that [the drawings] conform to the one-fourth circumference limitation almost exactly. But the claim requires only an approximation. Since we believe an amendment to the specification to state that one-fourth of the circumference is the aperture width would not violate the rule against "new matter," we feel that supporting disclosure exists. The rejection is therefore in error.

*Id.*

[3] These cases support our holding that, under proper circumstances, drawings alone may

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provide a "written description" of an invention as required by §112. Whether the drawings are those of a design application or a utility application is not determinative, although in most cases the latter are much more detailed. In the instant case, however, the design drawings are substantially identical to the utility application drawings.

Although we join with the district court in concluding that drawings may suffice to satisfy the "written description" requirement of §112, we can not agree with the legal standard that the court imposed for "written description" compliance, nor with the court's conclusion that no genuine issues of material fact were in dispute.

With respect to the former, the district court stated that although the '081 design drawings in question "allowed practice" [i.e., enabled], they did not necessarily

show what the invention is, when "the invention" could be a subset or a superset of the features shown. Is the invention the semi-circular lumens? The conical tip? The ratio at which the tip tapers? The shape, size, and placement of the inlets and outlets? You can measure all of these things from the diagrams in serial '081 and so can practice the device, but you cannot tell, because serial '081 does not say, what combination of these things is "the invention", and what range of variation is allowed without exceeding the scope of the claims. To show one example of an invention, even a working model, is not to describe what is novel or important.

745 F.Supp. at 522, 17 USPQ2d at 1356.

[4] We find the district court's concern with "what the invention is" misplaced, and its requirement that the '081 drawings "describe what is novel or important" legal error. There is "no legally recognizable or protected 'essential' element, 'gist' or 'heart' of the invention in a combination patent." *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 345 [128 USPQ 354] (1961). "The invention" is defined by the

claims on appeal. The instant claims do not recite *only* a pair of semi-circular lumens, or a conical tip, or a ratio at which the tip tapers, or the shape, size, and placement of the inlets and outlets; they claim a *double lumen catheter* having a *combination* of those features. That combination invention is what the '081 drawings show. As the district court itself recognized, "what Mahurkar eventually patented is exactly what the pictures in serial '081 show." 745 F.Supp. at 523, 17 USPQ2d at 1357.

We find the "range of variation" question, much emphasized by the parties, more troublesome. The district court stated that "although Mahurkar's patents use the same diagrams, [the claims] contain limitations that did not follow ineluctably [i.e., inevitably] from the diagrams." *Id.* at 524, 17 USPQ2d at 1357. As an example, the court stated (presumably with respect to independent claims 1 and 7 of the '329 patent) that

the utility patents claim a return lumen that is "substantially greater than one-half but substantially less than a full diameter" after it makes the transition from semi-circular to circular cross-section, and the \*1119 drawings of serial '081 fall in this range. But until the utility application was filed, nothing established that they had to - for that matter that the utility patent would claim anything other than the *precise* ratio in the diagrams....

*Id.* at 523, 17 USPQ2d at 1357. Mahurkar argues that one of ordinary skill in this art, looking at the '081 drawings, would be able to derive the claimed range.

The declaration of Dr. Stephen Ash, submitted by Mahurkar, is directed to these concerns. Dr. Ash, a physician specializing in nephrology (the study of the kidney and its diseases) and chairman of a corporation that develops and manufactures biomedical devices including catheters, explains why one of skill in the art of catheter design and manufacture, studying the drawings of the '081 application in early 1982, would have understood from them that the return lumen must have a

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diameter within the range recited by independent claims 1 and 7 of the '329 patent. Dr. Ash explains in detail that a return (longer) lumen of diameter less than half that of the two lumens combined would produce too great a pressure increase, while a return lumen of diameter equal or larger than that of the two lumens combined would result in too great a pressure drop. [FN7]"Ordinary experience with the flow of blood in catheters would lead directly away from any such arrangement," Ash states.

Although the district court found this reasoning "logical," it noted that later patents issued to Mahurkar disclose diameter ratios closer to 1.0 (U.S. Patent No. 4,584,968) and exactly 0.5 (U.S. Des. Patent No. 272,651). If these other ratios were desirable, the district court queried, "how does serial '081 necessarily exclude the[m]?" 745 F.Supp. at 523, 17 USPQ2d at 1357.

[5] The district court erred in taking Mahurkar's other patents into account. Mahurkar's *later* patenting of inventions involving different range limitations is irrelevant to the issue at hand. Application sufficiency under § 112, first paragraph, must be judged as of the filing date. *United States Steel Corp. v. Phillips Petroleum Co.*, 865 F.2d 1247, 1251, 9 USPQ2d 1461, 1464 (Fed. Cir. 1989).

[6] The court further erred in applying a legal standard that essentially required the drawings of the '081 design application to *necessarily exclude* all diameters other than those within the claimed range. We question whether any drawing could ever do so. At least with respect to independent claims 1 and 7 of the '329 patent and claims depending therefrom, the proper test is whether the drawings conveyed with reasonable clarity to those of ordinary skill that Mahurkar had in fact invented the catheter recited in those claims, having (among several other limitations) a return lumen diameter substantially less than 1.0 but substantially greater than 0.5 times the diameter of the combined lumens. Consideration of what the drawings conveyed to persons of ordinary skill is essential. *See Ralston Purina*, 772 F.2d at

1575, 227 USPQ at 179 (ranges found in applicant's claims need not correspond *exactly* to those disclosed in parent application; issue is whether one skilled in the art could derive the claimed ranges from parent's disclosure).

Mahurkar submitted the declaration of Dr. Ash on this point; Vas-Cath submitted no technical evidence to refute Ash's conclusions. Although the district court considered Dr. Ash's declaration, we believe its import was improperly disregarded when viewed through the court's erroneous interpretation of the law. [FN8] We hold that the Ash declaration and Vas-Cath's non-refutation thereof, without more, gave rise to a genuine issue of material fact inappropriate for summary disposition. *See Hesston Corp. v. Sloop*, 1988 U.S. Dist. LEXIS 1573, \*13 (D. Kansas) (summary judgment on §112 "written description" issue inappropriate where resolution of what parent disclosure conveyed to those skilled in the art may require examination of experts, demonstrations and exhibits).

\*1120 Mahurkar urges that at least some of the remaining claims do not contain the range limitations discussed by the district court, and that the presence of range limitations was not a proper basis for invalidating those remaining claims. For example, claim 8 of the '141 patent requires, *inter alia*, a smooth conical tapered tip and "the portion of said tube between said second opening and said conical tapered tip *being larger than* said first lumen in the transverse direction normal to the plane of said septum." Vas-Vath counters that claim 8 of the '141 patent is just as much a "range" claim as claims 1 and 7 of the '329 patent, albeit one having only a lower limit and no upper limit.

Absent any separate discussion of these remaining claims in the district court's opinion, we assume that the court applied to them the same erroneous legal standard. Summary judgment was therefore inappropriate as to the remaining claims. Additionally, the possibility that the '081 drawings may provide an adequate §112 "written description" of the subject matter of some of the claims but not others should have been considered. *See, e.g., In re Borkowski*, 422 F.2d 904, 909 n.4, 164 USPQ 642,

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646 n.4 (CCPA 1970) (on review of §112 non-enablement rejection: "A disclosure may, of course, be insufficient to support one claim but sufficient to support another.") On remand, the district court should *separately* analyze whether the "written description" requirement has been met as to the subject matter of *each* claim of the '141 and '329 patents.

#### CONCLUSION

The district court's grant of summary judgment, holding all claims of the '329 and '141 patents invalid under 35 USC 102(b), is hereby reversed as to all claims, and the case remanded for further proceedings consistent herewith.

#### COSTS

Each party to bear its own costs.

#### REVERSED and REMANDED

#### APPENDIX

##### *Independent Claims of the '329 Patent:*

1. A double lumen catheter having an elongated tube with a proximal first cylindrical portion enclosing first and second lumens separated by an internal divider, the proximal end of said elongated tube connecting to two separate connecting tubes communicating with the respective first and second lumens for the injection and removal of fluid, the first lumen extending from the proximal end of said elongated tube to a first opening at the distal end of said elongated tube, and the second lumen extending from the proximal end of said elongated tube to a second opening at approximately the distal end of said first cylindrical portion, wherein the improvement comprises:

    said elongated tube having at its distal end a smooth conical tapered tip that smoothly merges with a second cylindrical portion of said elongated tube, and said second cylindrical portion enclosing the first lumen from the conical tapered tip to approximately the location of said second opening, wherein said second cylindrical portion has a diameter substantially greater than one-half but

substantially less than a full diameter of said first cylindrical portion.

7. A double lumen catheter having an elongated tube with a proximal first cylindrical portion enclosing first and second lumens separated by an internal divider, the proximal end of said elongated tube connecting to two separate connecting tubes communicating with the respective first and second lumens for the injection and removal of fluid, the first lumen extending from the proximal end of said elongated tube to a first opening at the distal end of said elongated tube, and the second lumen extending from the proximal end of said elongated tube to a second opening at approximately the distal end of said first cylindrical portion, wherein the improvement comprises:

    said elongated tube having at its distal end a smooth conical tapered tip that smoothly merges with a second cylindrical portion of said elongated tube, and said second cylindrical portion enclosing the first lumen from the conical tapered tip to approximately the location of said second opening, said second cylindrical portion having a diameter substantially greater than one-half but substantially less than a full diameter of said first cylindrical portion, said divider in said first cylindrical portion being planar, the lumens being "D" shaped in cross-section in said first cylindrical portion, the elongated tube being provided with a plurality of holes in the region of the conical tapered tip, and said first cylindrical portion of the elongated tube smoothly merging with said second cylindrical portion of the elongated tube.

##### *Independent Claims of the '141 Patent:*

1. A double lumen catheter having an elongated tube with a proximal first cylindrical \*1121 portion enclosing first and second lumens separated by an internal divider, the proximal end of said elongated tube connecting to two separate connecting tubes communicating with the respective first and second lumens for the injection and removal of fluid, the first lumen extending from the proximal end of said elongated tube to a first opening at the distal end of

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said elongated tube, and the second lumen extending from the proximal end of said elongated tube to a second opening at approximately the distal end of said first cylindrical portion, wherein the improvement comprises:

said elongated tube having at its distal end a smooth conical tapered tip that smoothly merges with a second cylindrical portion of said elongated tube, and said second cylindrical portion enclosing the first lumen from the conical tapered tip to approximately the location of said second opening, wherein said second cylindrical [sic] portion has a diameter substantially less than a full diameter of said first cylindrical portion but larger than said first lumen in the transverse direction normal to the plane of said flat divider.

7. A double lumen catheter comprising an elongated cylindrical tube enclosing first and second lumens separated by a flat longitudinal internal divider formed as an integral part of said tube, said tube and said divider forming said first and second lumens as semi-cylindrical cavities within said tube, the proximal end of said elongated tube connecting to two separate connecting tubes communicating with the respective first and second lumens for the injection and removal of fluid, the first lumen extending from the proximal end of said elongated tube to a first opening at the distal end of said elongated tube, said distal end of said tube forming a smooth conical tapered tip and the second lumen extending from the proximal end of said elongated tube to a second opening spaced a substantial distance away from said first opening toward the proximal end of said tube, the distal end of said divider being joined to the outside wall of said tube distal of said second opening, and the outside wall of said tube forming a smooth transition between said conical tapered tip and the outer circumference of the tube proximal of said second opening, said transition being larger than said first lumen in the transverse direction normal to the plane of said flat divider.

8. A double lumen catheter comprising an elongated cylindrical tube having a longitudinal

planar septum of one-piece construction with said tube, said septum dividing the interior of said tube into first and second lumens, said lumens being D-shaped in cross-section, the proximal end of said tube connecting to two separate tubes communicating with the respective first and second lumens for the injection and removal of fluids, the lumen extending from the proximal end of said tube to a first lumen extending from the proximal end of said tube to a first opening at the distal end of said tube, and the second lumen extending from the proximal end of said tube to a second opening axially spaced from the distal end of said tube, said tube having at its distal end a smooth conical tapered tip that merges with the cylindrical surface of said tube, said first lumen, including the internal wall thereof formed by said septum extending continuously through said conical tapered tip, and the portion of said tube between said second opening and said conical tapered tip being larger than said first lumen in the transverse direction normal to the plane of said septum.

13. A double lumen catheter comprising an elongated cylindrical tube enclosing first and second lumens separated by a flat longitudinal internal divider formed as an integral part of said tube, said tube and said divider forming said first and second lumens as semi-cylindrical cavities within said tube, the proximal end of said elongated tube connecting to two separate connecting tubes communicating with the respective first and second lumens for the injection and removal of fluid, the first lumen extending from the proximal end of said elongated tube to a first opening at the distal end of said elongated tube, said distal end of said tube forming a smooth conical tapered tip defining the distal portion of said first lumen and said first opening, said first opening and an adjacent portion of said first lumen having a circular transverse cross-sectional configuration, and the second lumen extending from the proximal end of said elongated tube to a second opening spaced a substantial distance away from said first opening toward the proximal end of said tube, the inside walls of said tube forming a smooth transition between said semicylindrical and circular transverse cross-sectional configurations of said first lumen,

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the outside dimension of said transition being larger than said first lumen in the transverse direction normal to the plane of said flat divider.

FN1 The district court directed entry of final judgment as to the issue of patent invalidity pursuant to Fed.R.Civ.P. 54(b).

FN2 The utility patent drawings contain additional but minor shading and lead lines and reference numerals not present in the design application drawings.

FN3 Vas-Cath's apprehension of suit apparently arose from a 1988 Canadian action instituted by Mahurkar for infringement of Canadian '089.

FN4 Section 120, titled "Benefit of Earlier Filing Date in the United States," provides (emphasis ours):

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

FN5 For additional background, see Rollins, "35 USC 120 - The Description Requirement," 64 *J. Pat. Off. Soc'y* 656 (1982); Walterscheid, "Insufficient Disclosure Rejections (Part III)," 62 *J. Pat. Off. Soc'y* 261 (1980).

FN6 See, *Chester v. Miller*, 906 F.2d 1574, 15 USPQ2d 1333 (Fed. Cir. 1990) (parent application's disclosure of chemical

species constituted 102(b) prior art against continuation-in-part (c-i-p) application on appeal, but did not provide sufficient written description to support c-i-p's claims to encompassing genus); *In re Gostelli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989) (foreign priority application's disclosure of chemical subgenus was insufficient written description to support genus claims of corresponding U.S. application); *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) (application in "clear compliance" with § 112 "written description" requirement with respect to claim limitation that microcapsules were "not permanently fixed"); *Utter v. Hiraga*, 845 F.2d 993, 998, 6 USPQ2d 1709, 1714 (Fed. Cir. 1988) (holding generic interference count to scroll compressor supported by written description of foreign priority application, the court stated, "A specification may, within the meaning of 35 U.S.C. §112 P1, contain a written description of a broadly claimed invention without describing all species that claim encompasses"); *Kennecott Corp. v. Kyocera Int'l, Inc.*, 835 F.2d 1419, 5 USPQ2d 1194 a (Fed. Cir. 1987) (parent application's lack of express disclosure of inherent "equiaxed microstructure" property did not deprive c-i-p's claims to a sintered ceramic body having said property of the benefit of parent's filing date), cert. denied, 486 U.S. 1008 (1988); *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 227 USPQ 177 (Fed. Cir. 1985) (parent application's disclosure provided adequate written description support for certain claim limitations respecting protein content, temperature, and moisture content, but not others); *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984) (broadly worded title, general description of drawing, and objects of invention of parent patent application did not adequately support reissue application claims directed to genus of indicating

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mechanisms for dictating machines), *cert. denied*, 469 U.S. 1209 (1985); *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983) (claims to method of redeeming merchandise coupons, comprising step of providing an audit of coupon traffic, were not supported by specification of parent application).

FN7 Higher pressure drops are associated with smaller cross-sectional areas for fluid flow. Mahurkar's opening brief to this court states that by applying well-known principles of fluid mechanics (i.e., the work of Poiseuille and Hagen), it can be calculated that the diameter of the circular (return) lumen would have to be in the range of 0.66 times the diameter of the two lumens combined in order to achieve proper blood flow at equal pressure drop. The 0.66 ratio falls within the noted claim limitation.

FN8 The following colloquy at oral argument before the district court supports our view:

*Counsel for Mahurkar*: "So the only evidence that we have on this subject from people of ordinary skill in the art is that the drawings do communicate these range limitations, and given the procedural posture of this case, the Court has to accept that evidence...."

*District Court*: \* \* \* "And if you could have written a large number of things that were different from what was actually filed in 1984, then the diagram isn't enough.

And that seems to me something that can't be resolved by ogling the Ash declaration. It's really a pure question of law."

C.A.Fed.

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END OF DOCUMENT

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**C**

In re WOLFENSPERGER

Court of Customs and Patent Appeals

Appl. No. 6790

Decided May 18, 1962

United States Patents Quarterly Headnotes

**PATENTS****[1] Specification--Sufficiency of disclosure (§ 62.7)**

Disclosure, unequivocal in and of itself, may not be held wanting merely by reason of a speculation that one skilled in the art might interpret inventor's teaching in a remote and equivocal manner.

**PATENTS****[2] Drawings -- Disclosure in drawings only (§ 34.3)****Specification--Sufficiency of disclosure (§ 62.7)**

Statement that drawings alone cannot form basis of valid claim is too broad a generalization and is contrary to Patent Office practice; for example, sole disclosure in design patent is by means of a drawing; also, the only informative and significant disclosure in many electrical and chemical patents is by means of circuit diagrams or graphic formulae, constituting "drawings" in the case; to put matter in proper perspective, consideration must also be given to Patent Office practice, taken in conjunction with fundamental requirement that invention claimed must be disclosed in terms comprehensible to one of ordinary skill in relevant art.

**PATENTS****[3] Amendments to patent application--New matter (§ 13.5)****Amendments to patent application--Specification****(§ 13.7)****Drawings -- Disclosure in drawings only (§ 34.3)****Specification--Sufficiency of disclosure (§ 62.7)**

Patent Office Rule 118 authorizes amendment of words in specification so as to add statements not originally contained in it to conform to originally filed drawings; enquiry in each case is what drawing in fact discloses to one skilled in the art; whatever it does disclose may be added to specification in words without being prohibited new matter since what is originally disclosed cannot be new matter; if drawing contains necessary disclosure, it can form basis of valid claim; that is not to say that Office cannot enforce compliance with requirement of Rule 75(d) that terms and phrases used in claims must find clear support or antecedent basis in description so that meaning of terms in claims may be ascertainable by reference to description; necessity for amendment to specification is particularly applicable where applicant copies claim from another's patent; in determining whether there is supporting disclosure for claim, it is of no legal significance whether disclosure is found in specification or drawings.

**PATENTS****[4] Drawings -- Disclosure in drawings only (§ 34.3)**

In re Olson, 101 USPQ 401, does not support view that drawings alone cannot furnish supporting disclosure for copied claim; it stands only for proposition that disclosure is lacking if drawings relied on for supporting disclosure do not in fact contain it; in Thompson v. Dicke, 44 USPQ 514, fact situation also was that drawings did not contain supporting disclosure, not that drawings cannot contain such disclosure by themselves.

**PATENTS****[5] Amendments to patent application--Specification (§ 13.7)**

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**Specification--Sufficiency of disclosure (§ 62.7)**

In determining whether claim copied from another's patent reads on applicant's disclosed structure, question is not whether applicant has put application in such condition that patent can properly be issued to him but whether his original disclosure shows with sufficient clarity that he was in possession of invention claimed by patentee so as to establish his right to make claim and to so amend application, without adding anything new in the way of subject matter, that a patent might be issued to him containing such claim.

**PATENTS****[6] Drawings -- Disclosure in drawings only (§ 34.3)**

Statement in Vickery v. Barnhart, 49 USPQ 106, that drawings alone cannot form basis of valid claim and the fact that there is nothing in specification to refute showing of drawings is immaterial, is not sound law.

**PATENTS****[7] Drawings--In general (§ 34.1)****Drawings -- Disclosure in drawings only (§ 34.3)**

There is nothing in In re Olson, 101 USPQ 401, which is cited to support proposition that patent application drawings are not presumed to be drawn to scale or correct proportion, which raises presumption that drawings of instant application are not drawn to scale with reasonable accuracy or that four enlarged detailed figures consistently showing same relative proportions must be ignored; showing of drawings can be relied on as supporting disclosure for claim copied from another's patent.

**PATENTS****Particular patents--Valve**

Wolfensperger, Ball Type Valve, rejection of claim 33 of application reversed.

\*538 Appeal from Board of Appeals of the Patent Office.

Application for patent of Adolph Wolfensperger,

Serial No. 521,495, filed July 12, 1955; Patent Office Division 39. From decision rejecting claim 33, applicant appeals. Reversed.

STRAUCH, NOLAN & NEALE and JAMES E. NOLAN, both of Washington, D.C., for appellant.

CLARENCE W. MOORE (GEORGE C. ROEMING of counsel) for Commissioner of Patents.

Before WORLEY, Chief Judge, RICH, MARTIN, and SMITH, Associate Judges, and KIRKPATRICK, Judge. [FNa1]

RICH, Judge.

This appeal is from the decision of the Patent Office Board of Appeals affirming the examiner's rejection of claim 33, the sole claim before us, "as failing to read on applicant's disclosed structure." Appellant presented claim 33 in his application Ser. No. 521,495, filed July 12, 1955, entitled "Ball Type Valve," requesting an interference on this claim with Kaiser Patent No. 2,868,498 issued January 13, 1959, from which patent the claim was copied.

Appellant's invention relates to a ball type valve "for use in large high pressure fluid pipe lines up to 30 inches and more in diameter." Appellant's valve contains a shut-off member in the form of a roughly spherical ball plug having a diametral bore therethrough. The plug is rotatable about an axis perpendicular to the bore. When the bore in the ball plug is in alignment with the axis of the pipe line with which it is used, the valve is fully open. When the plug is rotated approximately 90 degrees out of alignment with the pipe line axis, the valve is closed.

Claim 33 reads:

33. In a valve device, in combination, a valve housing member formed with a bore therethrough; a valve arranged in said housing member, said valve being formed with a passage therethrough and being movable between open and closed positions wherein

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said passage is in and out of registration with said bore, respectively; and sealing means interposed between said housing member and said valve, said sealing means including an annular sealing member coaxial with said bore of said housing member, said members being so shaped as to form between themselves *an annular chamber* of substantially rectangular cross - section bounded by an inner face, an outer face and two side faces, and *a packing ring* arranged in said chamber, said ring being made of a resilient material and being compressed between said side faces of said annular chamber and *having, in un tensioned condition, a mean diameter corresponding approximately to the mean diameter of said chamber and a radial width smaller than the radial width of said chamber.* [Emphasis added.]

The sole question before us is whether the above italicized portion of appellant's claim is readable on his disclosed structure, one embodiment of which is reproduced in part below.

The drawing shows appellant's valve in the open position. Accordingly, fluid would tend to flow, if the high pressure side of the pipe line were to the right in the drawing, through openings 66, 100 and 106 in, respectively, valve housing 28, seat ring 80 and ball plug 24. The packing ring of the claim is shown in section at 90, seated in its annular chamber. It is, when unstressed, of circular cross-section and is a large "O-ring."

The main functions of appellant's O-rings are set forth in his specification as follows:

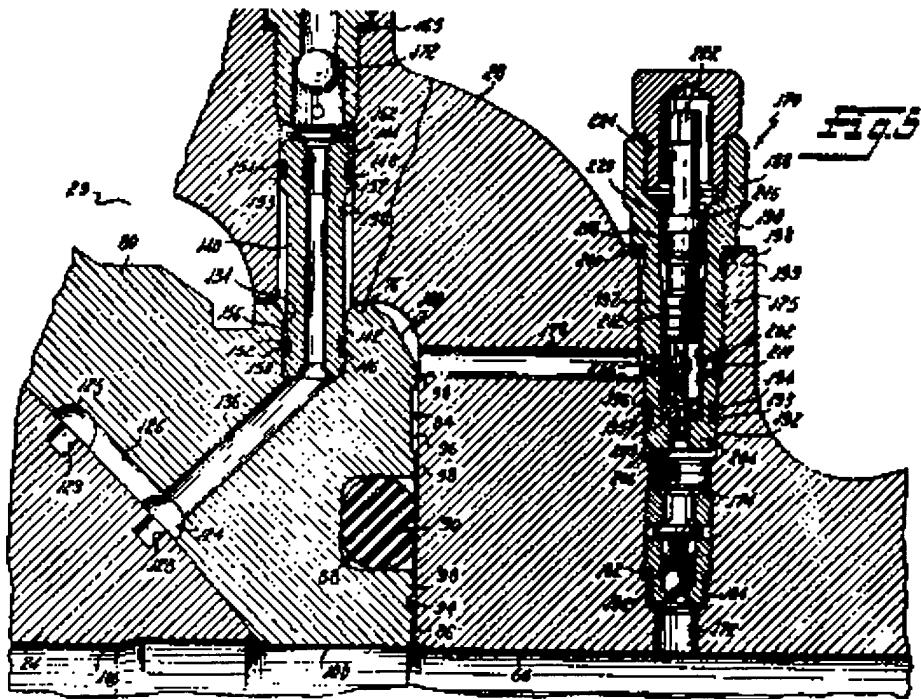
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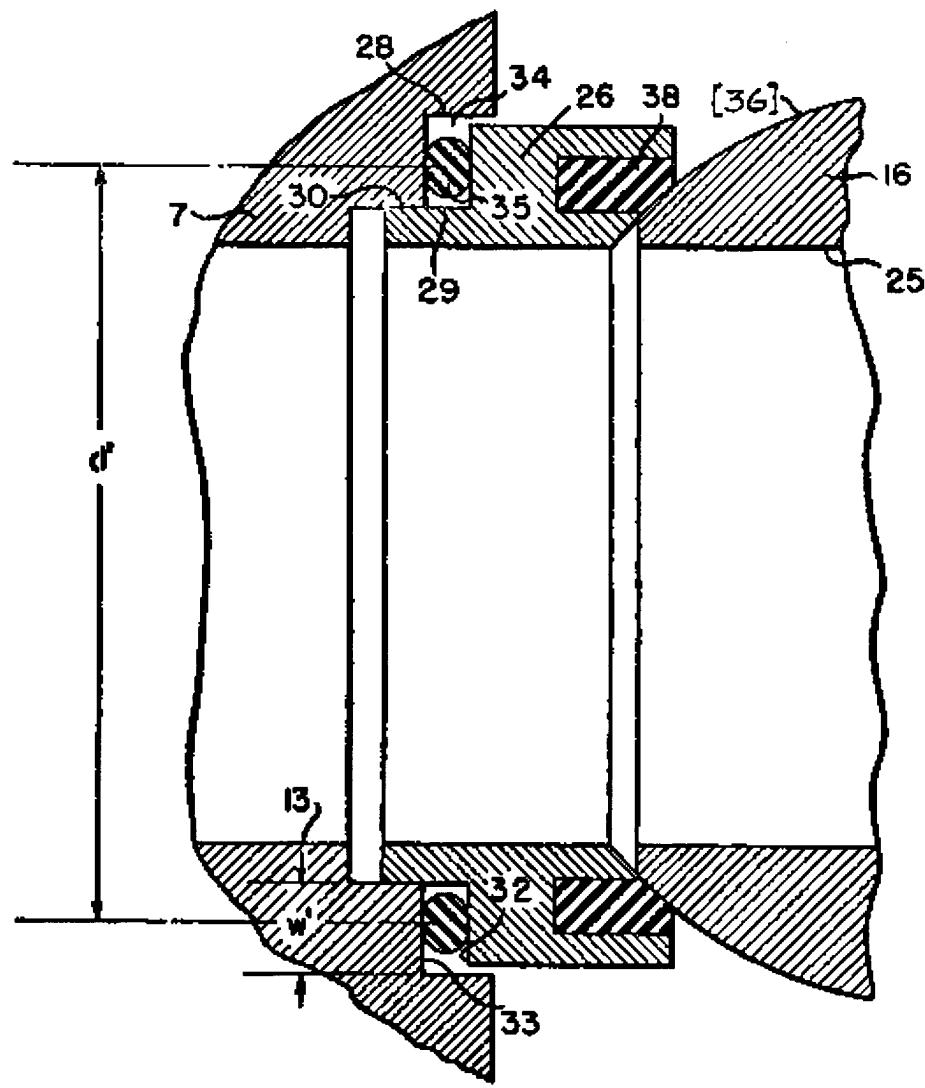


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**Figure 2 of Kaiser— 2,868,498**

When inserted in this chamber, the cross-sectional diameter of O-ring 35 is such that (1) "the said O-ring exerts an elastic pressure on the annular

piston 26 \* \* \* and presses the annular piston against the surface 36 of the ball plug 16," and that (2) "the O-shaped packing ring 35 is arranged in the

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compartment 34 spaced from the inner and outer faces thereof when the packing ring 35 is in untensioned condition." [FN2]

With the above comments on the disclosures \*541 of appellant and Kaiser as a background, we now turn to the italicized portion of claim 33, *supra*.

As noted by the board, this portion of the appealed claim recites two dimensional relationships, the first of which is that the "packing ring," in "untensioned condition," has "a mean diameter corresponding approximately to the mean diameter of said chamber." Looking at appellant's Figure 5, it is obvious that the ring *as shown* does have a mean diameter corresponding approximately to the mean diameter of the annular chamber formed by channel 88 and surface 84. The point raised by the Patent Office as to this disclosure, however, is that there is *no evidence* that the O-ring 90 *as it appears in channel 88* is in "untensioned condition." The board put it this way:

\* \* \* it is our opinion that the same symmetrical cross section would be obtained if the mean diameter of the untensioned ring were *smaller* than that of the chamber, *the ring being installed in the chamber by suitably stretching*. [Emphasis ours]

[1] The Patent Office cites in support of its position this court's decision of *Brand v. Thomas*, 25 CCPA 1053, 96 F.2d 301, 37 USPQ 505, wherein this court said that a "Lack of clear disclosure is not supplied by a speculation as to what one skilled in the art might do or might not do if he followed the teaching of the inventor." These words, however, are a two-edged sword. Using the reasoning of the *Brand* case, we find that a disclosure, unequivocal in and of itself, may not be held wanting merely by reason of a *speculation* that one skilled in the art might interpret the teaching of the inventor in a remote and equivocal manner. We find nothing in the disclosure of appellant, or elsewhere in the record, to suggest that one skilled in the art would place in appellant's "chamber" of Fig. 5 an O-ring which had to be stretched to fit the groove and

which would, in consequence, be in tensioned condition. Indeed, it seems to us that the Patent Office is stretching its imagination to find a lack of disclosure in this regard. We cannot agree with the board that appellant does not disclose the first-noted dimensional relationship. We do not think it was incumbent on the applicant to state, in respect of every O-ring in his structure, that it was so sized as to be untensioned when put in place. One would normally expect that to be the case.

The second dimensional relationship recited in claim 33 which the Patent Office considered not supported by appellant's disclosure is that, in untensioned condition, the packing ring has "a radial width smaller than the radial width of said chamber" (w' in Kaiser Fig. 2, *supra*).

In the partially flattened condition shown in appellant's Fig. 5, *supra*, packing ring 90 is shown as having a radial width which is the same as that of the chamber, which is the width of the annular groove 88 (the vertical dimension as shown in the drawing). However, in that showing the O-ring is not "untensioned." It is compressed almost to the full extent possible. The only problem in finding support for this claim limitation in appellant's disclosure arises from having to decide what one skilled in the art would understand the relative radial widths of the O-ring and the groove to be when the O-ring is in its uncompressed condition, a state nowhere illustrated in the drawings. The simple question which must be answered is whether it would be apparent to one skilled in the art that, on the basis of the whole disclosure, the ring's cross-sectional diameter when relaxed would be less than the radial width of "said chamber," i.e., less than the dimension in appellant's structure corresponding to dimension w' in Kaiser Fig. 2, *supra*.

On this point the board said:

\* \* \* appellant refers to Figure 5 of his drawings and contends that if the axial depth of the chamber, which is disclosed disclose as 7/8 inch, is used to establish the scale of Figure 5,

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the radial depth measured on the same scale is 1 1/8 inches, and since the cross-sectional diameter of the untensioned ring is disclosed as being 1 inch, the relationship claimed is shown in Figure 5. This argument is not convincing, since it is well established that drawings alone cannot form the basis of a valid claim. *Thompson v. Dicke*, 27 CCPA 931, 517 O.G. 564, 110 F.2d 98, 1940 C.D. 269, 44 USPQ 514. *In re Olson*, 41 CCPA 871, 685 O.G. 700, 212 F.2d 590; 101 USPQ 401, 1954 C.D. 167.

[2] The board's statement that "drawings alone cannot form the basis of a valid claim" is too broad a generalization to be valid and is, furthermore, contrary to well-settled and long-established Patent Office practice. We cannot regard it as "well established." Consider, for one thing, that the sole disclosure in a design patent application is by means of a drawing. Rule 153. For another thing, consider that the only informative and significant disclosure in many electrical and chemical patents is by means of circuit diagrams or graphic formulae, constituting "drawings" in the \*542 case. To put this matter in proper perspective, however, consideration must also be given to actual Patent Office practice, taken in conjunction with the fundamental requirement that the invention claimed must be disclosed, in terms comprehensible to one of ordinary skill in the relevant art.

[3] Patent Office Rule 118 authorizes, by implication at least, the amendment of the words in the written specification so as to add statements not originally contained in it to *conform* to originally filed drawings. Commenting on that rule, the Manual of Patent Examining Procedure, 3rd Ed. (MPEP), says, 608.04 (repeating a statement in 608.01 (1)):

In establishing a *disclosure* applicant *may rely* not only *on the specification and drawing as filed but also on the original claims if their content justifies it.* [Emphasis ours.]

The practical, legitimate enquiry in each case of this kind is what the drawing in fact discloses to one

skilled in the art. Whatever it does disclose may be added to the specification in words without violation of the statute and rule which prohibit "new matter," 35 U.S.C. 132, Rule 118, for the simple reason *that what is* originally disclosed cannot be "new matter" within the meaning of this law. If the drawing, then, contains the necessary disclosure, it *can* "form the basis of a valid claim."

This is not to say that the Patent Office, before permitting a patent to issue, cannot at the same time enforce compliance with another requirement, found in its Rule 75(d), that "the terms and phrases used in the claims must find clear support or antecedent basis in the description *so that the meaning of the terms in the claims may be ascertainable by reference to the description.*" [Emphasis ours.] This matter is further elucidated in MPEP 608.01(o) which clearly contemplates that it may be necessary to change or add to the language of the specification so as to provide proper support for the language of "new claims." It says:

While an applicant is not limited to the nomenclature used in the application as filed, yet whenever by amendment of his claims, he departs therefrom, he should make appropriate amendment of his specification so as to have therein clear support or antecedent basis for the new terms appearing in the claims.

This would appear to be particularly applicable to situations, such as that at bar, where the applicant copies a claim from the patent of another, since it is unlikely that independent specification writers will use identical language in describing even identical embodiments of an invention. A copied claim is, in a mechanical case, almost certain to use terminology which will not find "antecedent basis" in the application of the one who copies it. But that is not the issue. The issue here is whether there is supporting "disclosure" and it does not seem, under established procedure of long standing, approved by this court, to be of any legal significance whether the disclosure is found in the specification or in the drawings so long as it is there.

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(1959), states in Sec. 54 (p. 77):

Matter disclosed in the drawing alone, and not described in the specification as filed, has been held sufficient to support valid claims.

One of the cases cited in the footnote in support of that statement is this court's decision in *Kendall v. Searles*, 36 CCPA 1045, 173 F.2d 986, 81 USPQ 363, 367, wherein one issue, raised throughout the interference by Kendall's motion to dissolve on the ground that Searles' disclosure did not support the counts, was whether Searles' disclosed a ball-bearing, molded-plastic pulley wherein the parts were concentric and in axial alignment. This court said:

The board noted that appellee [Searles] made no statement in his specification about accurate concentric and axial alignment of the pulley work surface and the bearing raceway. The board further noted, however, that it appeared from appellee's drawings that such alignment was present \* \* \*.

The limitations of the counts appear to be clearly disclosed by appellee. His drawings show that all parts of his construction are concentric, \* \* \*. Accordingly, the court finds no manifest error in the concurring decisions of the tribunals of the Patent Office with respect to their disposition of appellant's motion to dissolve the interference.

[4] In support of its view in the instant case that "drawings alone cannot form the basis of a valid claim," i.e., furnish supporting disclosure for a copied claim, the board cites *In re Olson*, 41 CCPA 871, 212 F.2d 590, 101 USPQ 401. We have carefully considered that opinion and it is our view that it stands only for the proposition that if drawings which are relied on for supporting disclosure *do not in fact contain it*, then disclosure is lacking. The structure recited \*543 in Olson's claim and alleged not to be supported by his disclosure was equal spacing of certain ball seats in a self-sealing hydraulic fluid line coupling. The board pointed out that "the

distances and dimensions involved are of the order of *a few thousands of an inch* and it appears obvious that the drawing alone cannot be scaled off, *under these circumstances*, to show that any particular distances or sizes are exactly equal when the specification is completely silent in this respect." [Emphasis ours.] That is the decision this court affirmed. We do not find in that decision any support for the broad rule stated by the board in the instant case. We note, in passing, that the Patent Office Board of Appeals, as appears from its opinion in the record on file in this court, said, " \* \* \* while we agree with appellant that it is proper, under certain circumstances, to amend the specification to include subject matter shown in the drawing, we do not agree with him that this is proper in the present application." This immediately precedes the passage from the board opinion quoted in the Olson opinion. The Solicitor's brief (p. 6) also admitted, "Had any \* \* \* clearly disclosed features been neither disclosed nor claimed in the original application, claims could have been added to these features, and the specification amended to describe them."

The other case cited by the board is *Thompson v. Dicke*, 27 CCPA 931, 110 F.2d 98, 44 USPQ 514. There too we find the situation to have been, not that drawings *cannot* contain supporting disclosure by themselves, but that the drawings before the court did not in fact contain it. There was great diversity of opinion on this fact issue, the examiner and the board twice disagreeing on the matter and this court finally agreeing with the examiner, basing its decision on the findings that the drawing was "vague and non-informative" while the specification "contains no express teachings."

[5] In this phase of patent prosecution, the question is not whether an applicant has put his application in such condition that a patent can properly be issued to him but, rather, whether his original disclosure shows with sufficient clarity that he was in possession of an invention being claimed by someone else so as to establish his right to make the claim *and* to so amend his application, without adding anything new in the

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way of subject matter, that a patent *might* be issued to him containing such claim.

[6] Before leaving this point of law, we think it well to mention that we are not unaware of the existence of a sentence in one of this court's opinions, not referred to by the board or in the Patent Office brief, which closely parallels what the board said in this case. In Vickery v. Barnhart, 28 CCPA 979, 118 F.2d 578, 49 USPQ 106, 113, at CCPA p. 988, the court said:

It is well established that drawings alone in a patent application cannot form the basis of a valid claim, and the fact that "There is nothing in the specifications \* \* \* to refute this showing" (of the drawing) is immaterial.

The phrase quoted by the court was from appellee's argument. The court did not say when or wherein it had been so "well established" except to quote extensively from concluding obiter dictum in the opinion in Permutit Co. v. Graver Corp., 284 U.S. 52, 60, 11 USPQ 118, 121. We have carefully considered the Permutit case without finding a sound basis for the broad conclusion above quoted. In Permutit the Supreme Court predicated its decision on a finding that the invention being asserted by the plaintiff as patentable over the prior art--the use in a water softener of a "free" as distinguished from a "locked" bed of zeolites--was nowhere either disclosed or *claimed* in the patent in suit. It held the patent invalid for failure to comply with R.S. 4888 (predecessor to 35 U.S.C. 112). We do not, therefore, regard the above passage in the Vickery case as sound law. As to the facts respecting the drawings involved in that case, the Examiner of Interferences based his view on his finding that, "The dimensions in the drawing are so close that any difference in the minimum diameters [as claimed] could be attributable to a draftsman's error."

We cannot, for the reasons above stated, accept the assumed legal basis for the board's decision, because we deem it to be nonexistent, and turn now to the fact issue as to whether there is disclosure in appellant's application to support the count

limitation that "in untensioned condition" the O-ring has "a radial width smaller than the radial width of said chamber," referring to the chamber in which it is positioned when in use. This entails a consideration of the combined disclosure of the specification and drawings of appellant's application, for appellant does not rely on the drawings alone. His contention is "that there is a clear, correlated pictorial and descriptive dimensional disclosure."

The specification states:

*The drawings illustrate a thirty inch sphere valve embodiment wherein the \*544 relative dimensions and various structural reinforcing ribs and members having [sic] been designed for use in a specific system. [Emphasis ours.]*

In the drawings, Fig. 5, copied above in part, is but one of four substantially identical illustrations of the O-ring seal in question, the relative dimensions in particular being the same throughout the drawings which, it can be observed, are not in the least sketchy or diagrammatic in character. These showings of the seal are enlarged, carefully drawn details wherein the relative width and depth of groove 88 is clearly shown.

The specification states:

When the valve is open the large O-rings at the end walls of the seat rings, each having a cross-sectional diameter of approximately one inch and compressed in assembly approximately one-eighth inch, by their inherent resilience tend to center the seat rings and ball inside the valve body cavity with equal clearance between the back face of each seat ring and its valve body seat. The O-rings also provide a fluid tight seal between the back face of the seat ring and the valve body \*\*\*.

O-rings 90 which when relaxed are preferably of circular cross-section are of a sufficient diameter relative to the depth of grooves 88 to result in their compression between the seat rings 78 and 80 and the valve body recesses in

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the assembly by an amount greater than the total relative axial displacement between the seat rings and the plug and the body. [Emphasis ours.]

The Patent Office Solicitor admits that, "from the foregoing it is obviously deducible that the groove 88 is approximately 7/8 inch deep." Based on this obviously deducible fact and the statement, which is not disputed, that the cross-sectional diameter of the O-ring when relaxed is one inch, appellant says one skilled in the art would know that the relaxed ring was of less diameter than the radial width of groove 88 and so meets the claim limitation. To demonstrate how this would be known, the following diagram "Figure A" has been submitted, first with an affidavit of Paul A. Manor, Chief Engineer of the company which is assignee of the application at bar, and again in the brief.

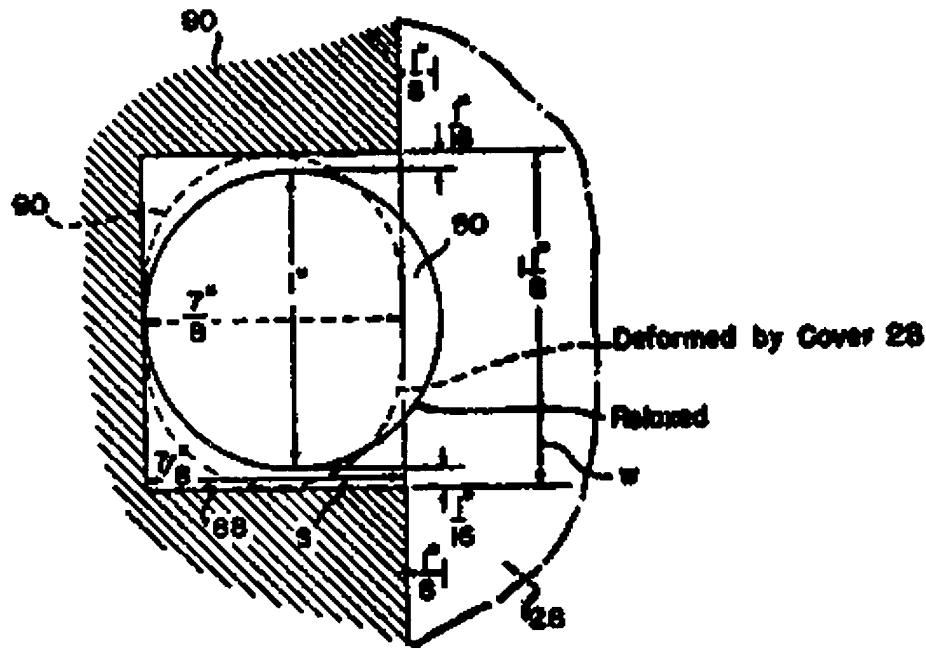


Figure A

What the above diagram shows, in brief, is that if

the depth of groove 88 is 7/8 inch, the drawings clearly shows, and consistently throughout the

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several figures, that the radial width of groove 88 must be about 1 1/8 inch and therefore that a one-inch O-ring would be of less width. The dotted outline 90 shows the \*545 O-ring as it is illustrated in the application drawings and the solid circle 90 shows how it would look when released from tension. We find this argument convincing. We also find that it reasonably supports the opinions expressed in the Manor affidavit that this is what one skilled in this art would be taught by the application.

[7] The principal counter argument of the solicitor is to the effect that appellant has no right to rely on the drawings for the relative width and depth dimensions which they show, for the reason that "patent application drawings are not presumed to be drawn to scale or correct proportion." Only the Olson case, *supra*, is cited to support this proposition. We find nothing therein, however, which raises a presumption that drawings such as those here are not drawn to scale with reasonable accuracy or that four enlarged detailed figures consistently showing the same relative proportions must be ignored. We think the showing of the drawings can be relied on to the extent they have been by applicant.

The decision of the board is *reversed*.

MARTIN, Judge, sat but did not participate because of illness.

FN1 United States Senior Judge for the Eastern District of Pennsylvania, designated to participate in place of Judge O'CONNELL, pursuant to provisions of Section 294(d), Title 28, United States Code.

FN1 This reproduction is from appellant's brief and he has added some reference numerals (taken from other figures) and the dimension lines d' and w'. Ring 35 has mean diameter d' and compartment 34 has width w'.

FN2 In the Kaiser structure, with the valve

16 closed and fluid attempting to flow outwardly through chamber 34 (to the right in Fig. 2), Kaiser discloses that O-ring 35 will be urged radially outward. Such radial expansion puts O-ring 35 under circumferential tension. In Kaiser, "untensioned condition," accordingly, refers to the condition of O-ring 35 when fluid pressure is *not* urging the O-ring to expand radially within chamber 34. However, for the purposes of deciding this case we do not limit it to that connotation and give it its ordinary meaning.

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